

REMARKS

Restriction to one of the following inventions has been required under 35 USC 121:

- I. Claims 1-5 and 12, drawn to a process for preparing polyurethane-polyacrylate hybrid secondary dispersions, classified in class 524, subclass 457;
- II. Claims 6-8, drawn to aqueous two-component coating compositions, classified in class 525, subclass 455; and
- III. Claims 9-11, drawn to a process for producing coatings from the product of group I and the coated article thereof, classified in class 427: subclass 445.

The Examiner contends that Inventions I and II are patentably unrelated and that the inventions cannot be used together as they have different modes of operation, different functions, or different effects. As the product for group I is not allowable, restriction is proper. (MPEP § 804.04, MPEP § 808.01).

The Examiner contends that Inventions II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using the product (MPEP § 806.05(h)). The Examiner contends that the process for using the product as claimed can be practiced without the crosslinker of group II.

Finally, the Examiner contends that Inventions I and III are related as process of making and process of using the product. Since the product is not allowable, restriction is proper between said method of making and method of using (MPEP § 806.05(i)).

In accordance with 37 CFR 1.143 the Applicants provisionally elect, with traverse, to prosecute Invention I, containing Claims 1-5 and 12. Applicants base their traversal on the fact that Inventions I and II are related as combination-subcombination as set forth in MPEP § 806.05(c). Applicants do not traverse the restriction between Inventions I and III and Inventions II and III.

With regard to Inventions I and II Applicants do not understand the Examiner's statement that these inventions are unrelated. In addition to process of making Claims 1-3, Invention I also contains Claims 4, 5 and 12, which are product claims directed to the polyurethane-polyacrylate hybrid secondary dispersions. Invention II requires the inventive secondary dispersions of Claim 4 and also a known crosslinker. Therefore, the subcombination is the polyurethane-polyacrylate hybrid secondary dispersion of Invention I (B_{sp}). The combination (AB_{sp}) is an aqueous coating composition containing the Invention I product and a known crosslinking agent. As stated in MPEP § 806.05(c) to support a requirement for restriction two-way distinctness is necessary:

The inventions are distinct if it can be shown that a combination as claimed

- (A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and
- (B) the subcombination can be shown to have utility either by itself or in other and different relations.

When these factors cannot be shown, such inventions are not distinct. (Emphasis added.)

MPEP § 806.05(c) continues under subheading II - SUBCOMBINATION ESSENTIAL TO COMBINATION by stating:

If there is no evidence that combination AB_{sp} is patentable without the details of B_{sp} , restriction should not be required. Where the relationship between the claims is such that the separately claimed subcombination B_{sp} constitutes the essential distinguishing feature of the combination AB_{sp} as claimed, the inventions are not distinct and the requirement for restriction must not be made, even though the subcombination has separate utility.

The situation presented under subheading II is exactly the situation presented in the subject application, i.e., the Invention I product is the essential distinguishing feature of the Invention II combination. In the absence of the secondary dispersion of Invention I, the Invention II combination only contains known crosslinking agents.

Because the Examiner cannot demonstrate that the combination does not require the particulars of the subcombination for patentability, the Examiner cannot satisfy the two-way distinctness requirement of MPEP § 806.05(c), especially as set forth under subheading 2.

MPEP § 806.05(c) also states that

In applications claiming plural inventions capable of being viewed as related in two ways, for example, as both combination-subcombination and also as different statutory categories, both applicable criteria for distinctness must be demonstrated to support a restriction requirement. See also MPEP § 806.04(b).

Accordingly, whether or not the Examiner can satisfy MPEP § 806.04(b) is irrelevant unless the Examiner can also satisfy MPEP § 806.05(c).

In view of the preceding remarks it is submitted that the Examiner has failed to satisfy the requirements necessary to restrict between Inventions I and II. Accordingly, it is requested that the restriction requirement be withdrawn and Claims 6-8 be examined with Invention I.

The foregoing is believed to be a complete response to the Office Action dated March 21, 2005, and in view of the preceding remarks, examination of Claims 1-8 and 12 is requested.

Respectfully submitted,

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